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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,041	06/15/2001	Glenn Philander Vonk	P-5013	5157

26253 7590 05/09/2011

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EXAMINER	
SEREBOFF, NEAL	
ART UNIT	PAPER NUMBER
3626	

MAIL DATE	DELIVERY MODE
05/09/2011	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLENN PHILANDER VONK, ANN K. FRANTZ, DAVID JOSHUA WHELLAN, CHRISTOPHER MICHAEL O'CONNOR, GEORGE B. GOLDMAN

Appeal 2011-001314
Application 09/881,041
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

FETTING, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE[1]

Glenn Philander Vonk, Ann K. Frantz, David Joshua Whellan, Christopher Michael O'Connor and George B. Goldman (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-7, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented a way for healthcare managers and providers to interactively cooperate with patients to monitor and evaluate patient status to provide the most appropriate treatment for the patients in the most cost-effective manner. Specification ¶ 0003.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

> 1. A system for monitoring health-related conditions of patients, comprising:
>
> [1] a plurality of remote monitoring stations,
>
> each being configured to receive patient health-related data pertaining to a respective patient; and
>
> [2] a computer network comprising
>
> a database containing accumulated health-related data pertaining to health-related conditions and treatments that reveals population trends and outcomes and

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[1] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed May 13, 2010) and Reply Brief ("Reply Br.," filed October 4, 2010), and the Examiner's Answer ("Ans.," mailed August 3, 2010).

at least one data access device configured to provide a health care provider access to said computer network and said database,

said computer network configured to

receive said patient health-related data pertaining to respective patients from said remote monitoring stations and

provide a health care provider with electronic treatment establishment tools to establish treatment programs for said patients

based on their respective patient health-related data and said accumulated health-related data, and

said computer network configured to

revise said accumulated health-related data

based on said patient health-related data

for identification of improvements in standards of care and medical practices that can be made for different ones of the health-related conditions;

[3] said remote monitoring stations being configured with electronic self-management tools for receiving from a respective patient said patient health-related data

relating to integration of a selected one of said treatment programs into the patient's lifestyle comprising

at least one of questions concerning health or treatment and responses to questions concerning health or treatment that are generated using said electronic self-management tools;

[4] said computer network being configured with electronic assessment tools

to allow a health care provider to assess said patient health-related data to determine

progress of the patient on the selected treatment program and

whether information, which relates to the selected treatment program and is selected to advise the patient on how to improve the integration of the selected treatment program into the patient's lifestyle,

needs to be conveyed to the patient in response to said progress determination.

The Examiner relies upon the following prior art:

Ballantyne	US 5,867,821	Feb. 2, 1999
Summerell	US 5,937,387	Aug. 10, 1999
Joao	US 6,283,761 B1	Sept. 4, 2001

Claims 1-7 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure.

Claims 1-7 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

Claims 1-7 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ballantyne, Joao, and Summerell.

ISSUES

The issues of written description and indefiniteness turn on whether the tools in limitation [4] are supported by the Specification and whether their scope is unknown. The issue of obviousness turns on whether the art describes the tools in limitation [4].

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

01. We adopt and incorporate by reference Findings of Fact numbers 1-28 from the prior appeal decision 2009-003953 in this application.

Further Facts Related to the Prior Art

Joao

29. Joao can be utilized by any provider, patient, and/or intermediary, to evaluate and/or monitor treatments and evaluate patients. Joao 29:9-15.

30. Joao's comprehensive database provides a data and/or information source which can be accessed by any provider, from anywhere in the world, and at any time, in order to obtain information about a patient in his, her, or its care. For example, a patient traveling far from home and out of reach by his or her current healthcare provider can be treated by another provider who can access the central processing computer 10, from any location, and at any time, and obtain up-to-date and/or comprehensive patient healthcare and/or medical and family history information, current healthcare and/or medical condition, current treatment and/or care and/or any other information which can facilitate optimal healthcare and/or medical treatment. Joao 30:9-21.

ANALYSIS

Claims 1-7 rejected under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure.

We are persuaded by the Appellants' argument that the Specification supports the claim 1 limitation [4] of the "computer network being configured with electronic assessment tools to allow a health care provider to assess said . . .data to determine . . .whether information, which . . . is selected to advise the patient on how to improve the integration of the selected treatment program into the patient's lifestyle, needs to be conveyed."

The Appellants cite several paragraphs to contend that the cited portions of the Specification "provides explicit support for information that relates to a selected treatment program and is selected to advise a patient on how to improve the integration of the selected treatment program into the patient's lifestyle." Appeal Br. 7-8; Reply Br. 4-8. We find these paragraphs in the Specification do support the limitation at issue. Paragraphs [0045], [0051], and [0093] are particularly pertinent.

Claims 1-7 rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

We are persuaded by the Appellants' arguments that the phrase "advise the patient on how to improve the integration" does not render the claim indefinite. Appeal Br. 8-10; Reply Br. 8-9. The Examiner found that the advice to be non-functional descriptive material and afforded no patentable weight. Ans. 4. This phrase comes from the same limitation in the written

description rejection, *supra*, and simply characterizes the tools, which are the actual structural limitation in the whole of limitation [4].

The issue then is whether the scope of tools that allow one to do what is recited in limitation [4] is indefinite. Although very broad, since any diagnostic tool would at least allow such activity, the scope would be understood by one of ordinary skill. While we agree with the Examiner that advice is non-functional descriptive material, the mere inclusion of such material, which is given no patentable weight, does not render a claim indefinite.

Claims 1-7 rejected under 35 U.S.C. § 103(a) as unpatentable over Ballantyne, Joao, and Summerell.

We are unpersuaded by the Appellants' argument that the applied art fails to describe limitation [4] of claim 1. Appeal Br. 10-11; Reply Br. 9-10. The Appellants contend that the information in limitation [4] is directed to the patient; whereas Joao directs information instead to a payer. Joao directs its information to many parties including the patient. FF 29 & 30. The Appellants further contend that Joao's information is limited to that of payment and reasons. We find that Joao provides information that support their assessments as claimed. *Id.*

Finally, in the Reply Brief, the Appellants contend that although Joao does provide tools for assessment and diagnosis, Joao does not do so to assess whether information needs to be conveyed. We find that whether Joao explicitly conveys or describes needing to convey such information is not dispositive, since the claim limitation only requires such tools that would allow assessment for such necessity. Clearly, any diagnostic tool would at

least allow for such an assessment, and Joao's tools go much further than mere primitive diagnostics.

CONCLUSIONS OF LAW

The rejection of claims 1-7 under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure is improper.

The rejection of claims 1-7 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention is improper.

The rejection of claims 1-7 under 35 U.S.C. § 103(a) as unpatentable over Ballantyne, Joao, and Summerell is proper.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 1-7 under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure is not sustained.
- The rejection of claims 1-7 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention is not sustained.
- The rejection of claims 1-7 under 35 U.S.C. § 103(a) as unpatentable over Ballantyne, Joao, and Summerell is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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